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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,620

08/05/2003

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EXAMINER

NGUYEN, QUYNH H

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

05/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,620

Applicant(s)

KATO ET AL.

Examiner

Quynh H. Nguyen

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 4/8/05 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 8-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 8-10, claim the non-statutory subject matter of a terminal control program to make a computer system execute a variety of processes for controlling a telephone terminal that performs a voice call. Data structures not claimed as embodied in a terminal control program to make a computer system execute a variety of processes for controlling a telephone terminal are descriptive material per se and are not statutory

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because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed terminal control programs to make a computer system execute a variety of processes for controlling a telephone terminal that performs a voice call are not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

Claim Objections

4. Claims 1, 3-5, and 8-9 are objected to because of the following informalities: claims 1, 3-5, and 8-9 recite NCU. It is unclear what is the acronym NCU for?. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimball (US Patent 5,953,322) in view of Norris et al. (US Patent 5,805,587).

As to claims 1, 8, and 10, Kimball teaches the steps of:

an NCU (Fig. 1, communications network 100) capable of inputting/outputting audio signals through the telephone line network (Fig. 1);

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an audio input/output path provided besides the NCU and capable of inputting/outputting audio signals from/to an outside source through an outside source through an Internet network (col. 5, lines 21-30);

a switch device for switching an output destination of audio signals based on audio input from the transmitter/receiver and an input source of audio signals to be output as audio from the transmitter/receiver from the NCU to the audio input/output path according to user's operation (col. 3, line 60 through col. 4, line 4; col. 5, lines 10-20).

Kimball does not teach a telephone call notification device for notifying reception of an incoming call from the telephone line network when the incoming call from the telephone line network is received in the state in which the output destination and the input source of audio signals have been switched to the audio input/output path by the switch device.

Norris et al. teaches a telephone call notification device for notifying reception of an incoming call from the telephone line network when the incoming call from the telephone line network is received (col. 1, lines 38-45; col. 6, lines 29-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Norris into the teachings of Kimball for the purpose of alerting a telephone subscriber that a call is coming when the subscriber's line is connected to the Internet, as discussed by Norris (col. 1, lines 32-35).

As to claims 2 and 6, Norris et al. teaches the telephone notification device makes audio indicating that an incoming call has been received from the telephone line network (col. 6, lines 30-35).

Claims 3 and 4 are rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Kimball teaches an Internet terminal (Fig. 1, cellular telephone 10) with an Internet call function allowing input/output of audio signals transmitted through an Internet network; and a terminal device connected to the Internet terminal through an audio transmission path for transmitting audio signals, wherein the Internet terminal makes the terminal device output audio based on audio signals to perform a voice call (col. 3, line 12 through col. 4, line 37).

Claim 5 is rejected for the same reasons as discussed above with respect to claims 4 and 5. Furthermore, Kimball teaches and Internet terminal (Fig. 1, cellular telephone 10) and a telephone terminal (Fig. 1, telephones 80, 82,...).

Claims 7 and 9 are rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Kimball teaches and Internet terminal (Fig. 1, cellular telephone 10).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Norris et al. (US Patent 6,961,333) teaches call-waiting feature for a telephone line connected to the Internet.

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Norris et al. (US Patent 6,842,448) teaches call-waiting feature for a telephone line connected to the Internet.

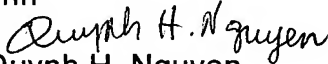
Norris et al. (US Patent 6,353,611) teaches call-waiting feature for a telephone line connected to the Internet.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

qhn


Quynh H. Nguyen
April 27, 2007